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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,034	09/05/2003	John N. Freskos	3316/0A/US	9057
28997	7590	04/27/2004	EXAMINER	
HARNESS, DICKEY, & PIERCE, P.L.C			DAVIS, ZINNA NORTINGTON	
7700 BONHOMME, STE 400			ART UNIT	
ST. LOUIS, MO 63105			PAPER NUMBER	
			1625	
DATE MAILED: 04/27/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/657,034	FRESKOS ET AL.	
	Examiner	Art Unit	
	Zinna Northington Davis	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-393 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-393 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I: Claims 1-121 and 380-393, drawn to a compound, composition and method of using of the formula (1-1).

Group II: Claims 122-197 and 380-393, drawn to a compound, composition and method of using of the formula (122-1) wherein E³ represent heterocycle.

Group III: Claims 122, 198-224 and 380-393, drawn to a compound, composition and method of using of the formula (122-1) wherein E³ represent carbocycle.

Group IV: Claims 225-234 and 380-393, drawn to a compound, composition and method of using of the formula (225-1).

Group V: Claims 235-249 and 380-393, drawn to a compound, composition and method of using of the formula (235-1).

Group VI: Claims 250-259 and 380-393, drawn to a compound, composition and method of using of the formula (250-1).

Group VII: Claims 260-266 and 380-393, drawn to a compound, composition and method of using of the formula (260-1).

Group VIII: Claims 267-295 and 380-393, drawn to a compound, composition and method of using of the formula (267-1).

Group IX: Claims 296-302 and 380-393, drawn to a compound, composition and method of using of the formula (296-1).

Group X: Claims 303-307 and 380-393, drawn to a compound, composition and method of using of the formula (303-1).

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Group XI: Claims 308-321 and 380-393, drawn to a compound, composition and method of using of the formula (308-1).

Group XII: Claims 322-334 and 380-393, drawn to a compound, composition and method of using of the formula (322-1).

Group XIII: Claims 335-336 and 380-393, drawn to a compound, composition and method of using of the formula (335-1).

Group XIV: Claims 337-343 and 380-393, drawn to a compound, composition and method of using of the formula (337-1).

Group XV: Claims 344-353 and 380-393, drawn to a compound, composition and method of using of the formula (344-1).

Group XVI: Claims 354-358 and 380-393, drawn to a compound, composition and method of using of the formula (354-1).

Group XVII: Claims 359-360 and 380-393, drawn to a compound, composition and method of using of the formula (359-1).

Group XVIII: Claims 361-367 and 380-393, drawn to a compound, composition and method of using of the formula (361-1).

Group XIX: Claims 368-371 and 380-393, drawn to a compound, composition and method of using of the formula (368-1).

Group XX: Claims 372-375 and 380-393, drawn to a compound, composition and method of using of the formula (372-1).

Group XXI: Claims 376-3793, drawn to a compound, composition and method of using of the formula (376-1).

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2. Inventions I-XXI are related as product claims. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product. For instance, see claims 1, 22, 225, 235, 250, 260, etc.
3. Inventions I-XXI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product. For instance, see claims 380-392.
4. This application contains claims directed to the following patentably distinct species of the claimed invention: A¹, A², A³, E¹, E², E³, E⁴, and E⁵.

The ring system and radicals within the definition of A¹, A², A³, E¹, E², E³, E⁴, and E⁵ are diverse in scope. A prior art reference, which anticipates one member of E³ such as pyridinyl under 35 U.S.C. 102, would not render obvious another member such as phenyl under 35 U.S.C. 103. Accordingly, the ring systems and the radicals are independent and patentably distinct.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).
7. Applicant is required under 35 U.S.C. § 121 to elect **a single disclosed species and a single disclosed method of use** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-393 are generic.
8. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
9. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims


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are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

10. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

11. Due to the complexity of the restriction requirement, a written request is made. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna N. Davis whose telephone number is (571) 272-0682.


ZINNA NORTHINGTON DAVIS
PRIMARY EXAMINER

Znd
4/23/2004